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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/576,187

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EXAMINER

CAILLOUET, CHRISTOPHER C

ART UNIT

PAPER NUMBER

1791

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/576,187	Applicant(s) BAIONI ET AL.	
	Examiner CHRISTOPHER C. CAILLOUET	Art Unit 1791	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 April 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>04/17/06</u> . | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1791

Examiner: Caillouet

March 12, 2009

DETAILED ACTION

1. The preliminary amendment filed April 17, 2006 has been received. Claims 7-15 were amended and claim 16 was cancelled.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, lines 1-3, recites the limitation, "Machine for the manufacture for immediate binding, having a strip of adhesive substance along one of its edges and a strip of silicone material positioned in a releasable manner on the strip of adhesive substance..." and in lines 5-7, "characterized in that it comprises along at least one production line thereof at least one applicator for applying a non-adhesive band onto the paper material advancing in a continuous manner along a feeding plane,". It is unclear whether the strip of silicone and the non-adhesive band are one in the same or separate bands to be applied by the apparatus in the process.

4. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 1, lines 11-12, recites the limitation, "means which define a travel path for movement towards the continuously advancing paper material, consisting of roller and band-guiding pulleys". It is unclear what this travel path is for,

Art Unit: 1791

specifically, is the pulleys for guiding the paper through the apparatus or are the pulleys for guiding the bands to a point binding with the paper.

5. Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 2 recites the limitation, "the applicator for applying the non-adhesive band onto the paper material also comprises a band cutter which can be activated at the terminal end of the advancing paper material." Although the claim applicator contains a "band cutter", the claim language would indicate that the cutter is activated at the terminal end of the paper material, which would imply that it also cuts said paper material.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claim 1-3, 10-11 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Blümle (US 5776285).

As to claim 1, Blümle discloses an apparatus for applying adhesive to a closure flap of an envelope (Fig. 1; Abstract). Blümle discloses that the machine applies a non-adhesive band/carrier strip (3A) with an adhesive (4) on one of the sides of the envelope so that when said strip is removed, it exposes the adhesive on the envelope for immediate binding (Abstract; Fig. 3). As disclosed in Fig. 5, the apparatus

Art Unit: 1791

comprises of: A supply roll (20) that dispenses a web of silicone paper (15; column 5, lines 38-40) guide rollers (13A, 10A, 10B that guide said web to an adhesive application nozzle (40A); a roller (21A) situated above the envelope material coupled with a counter roller (24A) for application of carrier strip (3A) with adhesive to said envelope (column 6, lines 21-51).

As to claim 2, the apparatus of claim 1 is taught as seen above. Blumle further discloses that roller (21A) has a cutting edge (22A) for severing the carrier strips from the web (15) (Id.).

As to claim 3, the apparatus of claim 1 is taught as seen above. Blumle discloses that upper and lower drive rollers (25 and 26) are used for moving the envelopes through the apparatus (Fig. 1; column 3, lines 39-40).

As to claims 10 and 11, the apparatus of claim 1 is taught as seen above. Blumle discloses that the apparatus has a collection table/single stage device for collecting the finished product (Fig. 1; column 3, lines 31-33).

As to claim 14, Blumle discloses that the carrier web comprises of silicone paper (15; column 5, lines 38-40).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blümle (US 5776285) as applied to claim 1 above, and further in view of Blümle (US 5558612) and Rodriguez et al. (US 5417383).

Blumle '285 ('285) discloses that the adhesive applicator (1) is part of an article manufacturing machine (27) wherein a first section (28), upstream of the adhesive applicator (1), forms the discrete envelopes ready for application of adhesive strips (Fig. 1; column 3, lines 21-39). Blumle '612 discloses a machine for manufacturing envelopes wherein envelopes are made from a web of material by folding and bonding said web to itself, and finally severing the web after folding so as to form individual envelopes (Fig. 3, Fig. 2; column 4, lines 15-56). It would have been obvious to one of ordinary skill in the art to use a known successful apparatus for producing individual envelopes, such as the apparatus disclosed by Blumle '612, in the machine (27) of Blumle '285 because the use of such an apparatus would have been well within his technical grasp.

Blumle '612 fails to disclose whether an encoder with the circumference equal to the length of an article to be produced and capable of rotating in synchronism with the drive roller, coupled with a contact cutter may be used to sever the envelopes from the web of material. It is the position of the examiner that the use of an encoder coupled with a contact cutter to measure and cut exact lengths of material from a web is well known in the art and would have been obvious to one of ordinary skill at the time of the invention. Rodriguez et al. (Rodriguez) discloses a apparatus cutting a web of material that uses an encoder (28) to measure a distance/amount of web that has passed in

Art Unit: 1791

order to activate a cutter (14) to make cuts in the web, thus forming sections of material of a specified length (Fig. 1; column 3, lines 26-38). Thus, it would have been obvious for one of ordinary skill to a known successful apparatus for severing measured articles from a web, such as the encoder coupled with a cutter as taught by Rodriguez, in the apparatus of the above references combined because the inclusion of such an apparatus would have been well within his technical grasp.

The circumference of the encoder wheel is used to calculate the distance that the web has traveled by counting the number of revolutions the encoder wheel makes. Using an encoder wheel with a circumference equal to the length of the article to be cut would provide that each rotation of the wheel would provide a count for which the cutter would be activated to cut the web to create a piece of material of a predetermined length. Since the correlation between the circumference of the encoder number of revolutions said encoder makes measures the amount of material passing by, varying the circumference of the encoder and determining the number of revolutions needed to make a cut to produce an article of desired length would have been well within one of ordinary skill's technical grasp, thus, using an encoder wheel with a circumference equal to that of the length of the article to be severed would have been obvious to one of ordinary skill at the time of the invention.

10. Claim 5 rejected under 35 U.S.C. 103(a) as being unpatentable over Blümle (US 5776285) as applied to claim 1 above, and further in view of Takahashi et al. (US 4670081).

Blumle fails to disclose the use of dual belts to convey the envelopes through the applicator apparatus (1) (Fig. 1.). Takahashi et al. (Takahashi) discloses a envelope handling machine wherein a label (L) is laminated to an envelope (E) and then retained under pressure as it continues to move through the apparatus by upper and lower belts (8, 9) (Fig. 1; column 2, lines 32-57). The belts sandwich the envelope and label together for a distance past the original point of contact to allow for an extended pressing time to help ensure complete adhesion between the label and the envelope. It would have been obvious for one of ordinary skill in the art to incorporate the belts of Takahashi into the apparatus of Blumle because one of ordinary skill would recognize the advantage of extra press time for the carrier strip and the envelope, aiding in a more complete adhesion between the two articles.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the dual belt conveyor of Takashashi et al. in the apparatus taught by Blumle because one of ordinary skill in the art would have been able to carry out such a substitution to achieve the predictable result of a working conveyance for moving the envelopes through the applicator section. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007).

11. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blümle (US 5776285) as applied to claim 1 above, and further in view of Blumle (US 6572520).

Art Unit: 1791

Blumle '285 fails to disclose the use of a vacuum belt for conveying the envelopes through the apparatus. It is the position of the examiner that using vacuum belts to convey an article through an apparatus is well known in the art and would have been obvious to one of ordinary skill at the time of the invention. Blumle '520 discloses the use of a vacuum belt to transport envelope blanks in an envelope making machine (Fig. 2, Fig. 3; column 1, lines 7-11; column 5, lines 27-40). Blumle '520 discloses the use of such vacuum belts ensures that the envelope is retained on the belt in a stable condition as they are transported through the machine (column 1, lines 47-52). It would have been obvious for one of ordinary skill in the art to substitute the vacuum belt of Blumle '520 for the rollers of Blumle '285, because Blumle '520 teaches that the vacuum belt gives the added benefit of ensuring that the envelope is in a stable condition as it is transported through the envelope making machine.

12. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blümle (US 5776285) as applied to claim 1 above, and further in view of Blümle (US 5558612) and Blümle (US 4795414).

Blumle '285 ('285) discloses that the adhesive applicator (1) is part of an article manufacturing machine (27) wherein a first section (28), upstream of the adhesive applicator (1), forms the discrete envelopes ready for application of adhesive strips (Fig. 1; column 3, lines 21-39). Blumle '612 discloses a machine for manufacturing envelopes wherein envelopes are made from a web of material by folding and bonding said web to itself, and finally severing the web after folding so as to form individual envelopes (Fig. 3, Fig. 2; column 4, lines 15-56). It would have been obvious to one for

Art Unit: 1791

ordinary skill in the art to use a known successful apparatus for producing individual envelopes, such as the apparatus disclosed by Blumle '612, in the machine (27) of Blumle '285 because the use of such an apparatus would have been well within his technical grasp.

Blumle '612 discloses that folding lines are made in the web of material to be folded into an envelope, but fails to disclose how these lines are formed. It is the position of the examiner that using a scoring wheel/groove disc to form foldlines in a web of material is well known in the art and would have been obvious to one of ordinary skill at the time of the invention. Blumle '414 discloses an apparatus for forming grooves in a web of material (column 1, lines 4-16). Said grooves serve as foldlines to form the envelope (Id.). Blumle '414 discloses that a grooving disc is used to form the foldlines in the web (column 2, lines 19-29; Fig. 1). It would have been obvious to one of ordinary skill to incorporate the foldline forming apparatus of Blumle '414 into the apparatus of the above references combined, because such incorporation would have been well within his technical grasp.

13. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blümle (US 5776285) as applied to claim 1 above, and further in view of Bay (US 6146728).

Blumle '285 fails to disclose the use photocell to monitor and control the rate at which the envelopes are passing through the apparatus. It is the position of the examiner that using a photocell to monitor and control the feed rate of a material is well known in the art and would have been obvious to one of ordinary skill at the time of the invention. Bay discloses a labeler that uses electronic control means to regulate the

Art Unit: 1791

timing and positioning of labels and envelopes to obtain accurate registration there between. Bay discloses that an advantage of an electronic control means over prior art which uses sprocket wheels to obtain proper registry between label and envelope is that the electronic control means relatively simple and more economical (column 1, lines 14-28). Bay discloses an envelope labeling apparatus that uses photocell sensors to control and synchronize the envelope and label feed means in order to properly register said labels to envelopes (Fig. 17; Abstract; column 5, lines 33-40). It would have been obvious for one of ordinary skill in the art to incorporate the photocell control device of Bay into the apparatus of Blumle and would have been motivated to do so because Bay teaches cost effective apparatus for accurate registration of adhesive strips to envelopes.

14. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blümle (US 5776285) as applied to claim 1 above, and further in view of Blümle (US 5558612) and Baker et al. (US 5196083).

Blumle '285 ('285) discloses that the adhesive applicator (1) is part of an article manufacturing machine (27) wherein a first section (28), upstream of the adhesive applicator (1), forms the discrete envelopes ready for application of adhesive strips (Fig. 1; column 3, lines 21-39). Blumle '612 discloses a machine for manufacturing envelopes wherein envelopes are made from a web of material by folding and bonding said web to itself, and finally severing the web after folding so as to form individual envelopes (Fig. 3, Fig. 2; column 4, lines 15-56). It would have been obvious to one of ordinary skill in the art to use a known successful apparatus for producing individual

Art Unit: 1791

envelopes, such as the apparatus disclosed by Blumle '612, in the machine (27) of Blumle '285 because the use of such an apparatus would have been well within his technical grasp.

The above references as combined fail to disclose the use of a control panel for entering desired parameters to a controller for the envelope manufacturing machine. It is the position of the examiner that using a control panel to input desired parameters for controller to operate an apparatus is well known in the art and would have been obvious to one of ordinary skill at the time of the invention. Baker discloses an apparatus for producing mail pieces in a desired configuration (Abstract). Baker discloses that the controller operates all of the machinations of the apparatus (column 8, lines 16-38). Baker discloses that a user inputs with the control panel (Fig. 1; 1, 2, 4) the desired parameters for the job and the controller implements said commands to cause the apparatus to produce a mail article of desired configuration (column 8, lines 50-60). Insofar as the above references as combined and Baker et al. are analogous arts from the same field of endeavor of mail piece production, it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the control panel with controller of Baker et al. into the envelope manufacturing apparatus of the above references as combined. This would have been an obvious improvement to one of ordinary skill in the art since it is extraordinarily well known that a control input panel with controller would allow for operational flexibility and to vary the size and shapes of the envelopes produced by the apparatus of Blumle '612 and Blumle '285.

Art Unit: 1791

15. Claims 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Blümle (US 5776285) as applied to claim 1 above, and further in view of Russell (EP 1208999).

As to claim 12, Blumle fails to disclose the use of a multiple-stage device for collecting the finished product. It is the position of the examiner that using a multi-stage device for collecting articles is well known in the art and would have been obvious to one of ordinary skill at the time of the invention. Russell discloses a document production machine which produces documents with an adhesive strip (Abstract). Russell discloses the use of a multi-stage device for separating and collecting the finished articles into specific groups (Fig. 3; paragraph 36). A multi-stage separator is advantageous over a single-stage separator because multiple jobs may be programmed into the apparatus without requiring an operator to sort through jobs by hand at the end of said jobs. Insofar as Blumle and Russell are analogous arts from the same field of endeavor document production, it would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the multi-stage collection device of Russell into the apparatus of Blumle. This would have been an obvious improvement to one of ordinary skill in the art since it is extraordinarily well known in the art of document production that a multi-stage allows for operational flexibility since the operator of said apparatus would not have to stand by and wait for each job to finish or sort through the jobs by hand.

Furthermore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the multi-stage collection device of Russell in the apparatus taught by Blumle because one of ordinary skill in the art would have been able to carry

Art Unit: 1791

out such a substitution to achieve the predictable result of an apparatus that is able to sort and collect various jobs programmed into said apparatus. "The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 82 USPQ2d 1385 (2007).

16. Claims 13 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blümle (US 5776285).

As to claim 13, The method of claim 1 is taught as seen above. Blumle fails to disclose whether the apparatus may comprise of two tracks for processing envelopes. It is the position of the examiner that adding another track for processing envelopes would have been obvious to one of ordinary skill in the art at the time of the invention because one of ordinary skill would recognize that adding another track would double the processing capacity of the apparatus. *Mere duplication of parts has no patentable significance unless a new an unexpected result is produced.* In re Harza, 274 F.2d 669, 124 USPQ 378 (CCPA 1960).

As to claim 15, the method of claim 1 is taught as seen above. Blumle discloses that the carrier material may be any suitable material that has an inherent anti-stick characteristic such as a smooth surface (column 5, lines 29-31), but fails to specifically disclose whether polyester is such a material. It is the position of the examiner that a polyester carrier strip would have a smooth surface, and therefore qualify as a suitable material with an inherent anti-stick characteristic envisioned by Blumle.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER C. CAILLOUET whose telephone number is (571)270-3968. The examiner can normally be reached on Monday - Thursday; 9:30am-4:00pm, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Phillip Tucker can be reached on (571) 272-1095. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Caillouet/
Examiner, Art Unit 1791

/Philip C Tucker/
Supervisory Patent Examiner, Art Unit 1791